"[I]t is proper to take into account not only specific teachings of the reference but also the inferences which on skilled in the art would reasonably be expected to draw *therefrom*." MPEP §2144.01 (italics added). "It is important for an examiner to properly communicate the basis for rejection so that the issues can be identified early and the

5   applicant can be given fair opportunity to reply." MPEP §706.02(j). In the present rejection of claim 1, there has been no clear communication of the teachings of Alberts, their relationship to claim 1, and the inferences *therefrom* which the Examiner believes one of ordinary skill would draw in order to realize Applicant's claimed invention.

Upon considering the elements of claim 1, one finds that the "accepting a

10   subscriber advertising profile" is not taught or suggested by Alberts. Alberts suggests that classifications of groups of subscribers (i.e., children vs. adults, home site access vs. work site access) may be used to concentrate or intensify ads to these groups, but Alberts does not suggest a profile for an individual subscriber (as individualization provides just the opposite of concentration). See col. 1, lines 44-48. One fundamental

15   difference between the purposes of Applicant's invention and Alberts' invention is that Alberts is directed to optimizing banner advertising for the advertiser while Applicant's invention is directed to optimizing advertising for the subscriber. See the application page 5, line 11; page 6, line 2; page 6, line 6; page 6, line 14; and page 7, line 8. Compare to Alberts' statement: "It would be desirable for a web site administrator that

20   sells ads based on a number of hits per day to have an efficient way to cause the appropriate number of ads to be served and to be able to adapt to different situations in a flexible manner." Col. 1, lines 49-52. Thus, inferences that can be drawn by one of ordinary skill must respect the objective of the invention, not open to speculation - particularly speculation derived from Applicant's teachings.

25   The next element of claim 1, "storing...", as well as "recalling...", will be explored below. Applicant's "determining an attribute of and a time significance for an advertisement" and "comparing said subscriber advertising profile to said attribute" is not suggested by Alberts. Alberts discloses information that is associated with advertisements is kept in a table (30) in the advertiser's database (20) and includes an ad

30   identifier (34) and triggering information (42). The ad identifier is a URL or a pointer to a graphical or textural object. See col. 3, lines 37-41. The triggering information is defined as the region from which the user has accessed Alberts' system or the content which the user has currently accessed. See col. 7, lines 11-21. Note that while an

attribute of the advertising, for example a region in which a business exists, may be implicitly disclosed by Alberts and recognized by one of ordinary skill, it is too long a stretch of the imagination to find an implicit comparison of this to a subscriber-stored profile, which Alberts does not suggest. Alberts discloses a comparison being made to parameters of the immediate access by the user (location and/or content accessed during the immediate session). Moreover, Alberts does not include a time significance that is compared to a current time of the subscriber. Alberts teaches that ad frequency, ad intensity at times during the day, a start date, and a stop date or run length can be made part of the ad information table (30). See col. 3, lines 41-46 and col. 2, lines 30-34. It is noteworthy that any advertising time concerns are not related to the user, rather they are related to the advertising and support Alberts' objective stated at col. 1, lines 49-52. There is no determining of a current time of the subscriber by Alberts, thus there can be no "comparing said current time to said time significance" as required in claim 1. The regionality described by Alberts at col. 7, lines 11-14 is directed to business location in a region defined by the advertisements. While Alberts includes a banner advertisement with content, it is not done with the subscriber time and profile matches described above.

Examiner has acknowledged that the element "storing said subscriber advertising profile at the server..." is not disclosed by Alberts but believes Applicant's required step is implicit in the Alberts disclosure. Applicant is specifically directed to col. 1, lines 55-65 and col. 4, lines 10-26. Alberts explicitly identifies components of the advertising system: an advertising server, an advertising database, and an advertising controller. The database is clearly defined as only for "stor[ing] information about the ads". Col. 1, lines 61-62. Specifically, there is information storage for statistics for accurate control of the serving of ads (col. 4, lines 6-10), reports for a system manager (col. 4, lines 12-14), and verification to advertisers that ads were actually displayed (col. 4, lines 21-23). Alberts has made it clear that the invention is for the efficiency of the web site administrator (col. 1, lines 49-52), not for the convenience of the user. This is borne out in Alberts' summary where it is stated that Alberts' invention "...provides an integrated system that allows ads to be served in a highly flexible and accurate manner a desired number of times throughout the day and evenly distributed during the day, or intensified at times if desired." Col. 2, lines 30-34. This system accommodation of the needs of the advertiser does not suggest, or motivate one of ordinary skill to experiment to

incorporate, a subscriber preference storage. Moreover, the serving of ads based on immediate events (such as the location or content accessed, summarized at col. 2, lines 30-40) does not provide motivation to explore a subscriber preference storage. Given the intent of Alberts, there is no implication or suggestion that there should be a storage

5   mechanism for a subscriber's preferences and it is only after learning of Applicant's invention that such an implication can be drawn.

Thus, Examiner has apparently drawn a substantial number of inferences to support a claim of obviousness based upon implicit disclosure. Applicant has attempted to identify claim elements, express teachings by Alberts, and inferences presumably

10   intended by Examiner. The sheer number and extent of these inferences cannot be deemed proper and are created only when Applicant's claimed invention is used as a recipe for Examiner's inferences. A §103 rejection cannot be maintained for claim 1 and, because of the similarity of claim 9, for claim 9. Claims 2 and 9 should be deemed allowable.

15   Examiner believes Alberts implicitly shows all of the elements and limitations of claims 2-8 and 10-16 but lacks explicit recitation of some of the elements and limitations of these claims. In accordance with MPEP §706.02(j), Applicant requests more information about which elements are implicit in specific sections of Alberts disclosure so that Applicant can be given a fair opportunity to reply. Moreover,

20   Examiner has taken "Official Notice" that both the concepts and advantages of all of the elements and limitations of claims 2-8 and 10-16 were well known and expected in the art. Applicant respectfully traverses such an assertion and requests (in accordance with MPEP §2144.03) a reference in support of Examiner's position or, if the Examiner is personal possession of knowledge of the notoriety of the concepts and advantages of the

25   claimed elements, an affidavit from the Examiner regarding such knowledge. The citation from Alberts quoted by Examiner (that Alberts' invention "...provides an integrated system that allows ads to be served in a highly flexible and accurate manner a desired number of times throughout the day and evenly distributed during the day, or intensified at times if desired." Col. 2, lines 30-34) does not provide a basis for

30   modification to realize, for example, the steps of determining a current time (claims 2 and 10) or delivering content and advertising with a request and/or predetermined schedule of the subscriber (claims 6, 7, 8, 14, 15, and 16). The citation from Alberts quoted by Examiner (that "[d]ifferent ads can be served based on differing triggering
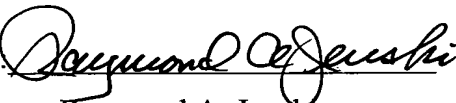
events, such as the location of the user, the type of information being accessed by the user, or the categories accessed." Col. 2, lines 34-37) does not provide motivation for any modification of the foregoing claims since the triggering events are real-time user access events that are not suggestive of stored user preferences. See col. 7, lines 7-21.

5   Accordingly, a rejection of claims 2-8 and 10-16 under 35 U.S.C. §103 is not proper. These claims are dependent upon presumed allowable independent claims and should be deemed allowable as such.

Therefore, in view of the foregoing Remarks, Applicant believes the present Application to be in a condition suitable for allowance. Examiner is respectfully urged

10   to withdraw the rejections upon reconsideration of the Remarks and pass the present Application to allowance.

Hewlett-Packard Company   Respectfully submitted,

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